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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,511	11/30/2000	Hiroaki Ishizuka	197792US28	8903
22850	7590	03/19/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			SNAPP, SANDRA S	
			ART UNIT	PAPER NUMBER
			3624	
DATE MAILED: 03/19/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/725,511

Applicant(s)

ISHIZUKA, HIROAKI

Examiner

Sandra Snapp

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 November 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Specification

The abstract of the disclosure is objected to because there is extraneous information on line 10 that should be deleted. Correction is required. See MPEP § 608.01(b).

Drawings

This application lacks formal drawings. The informal drawings filed in this application are acceptable for examination purposes. When the application is allowed, applicant will be required to submit new formal drawings.

Claim Objections

Claim 1 is objected to because it has a period at the end of line 7 and another at the end of line 9. The claims should be one sentence, so it is recommended the period at the end of line 7 be deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 3, 7, 26 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite because each has the phrase "a lease" yet all depend from claims wherein a lease was already recited thereby providing antecedent basis for subsequent references to "the" or "said" leases.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 9-24 and 32-46 are rejected under 35 U.S.C. 102(b) as being anticipated by the Mandler et al. patent (US 5,732,400).

The Mandler patent discloses a method, and associated means, of communicating, comprising:

Means for storing a customer's financial information based on an off-line transaction (col. 3, lines 39-43), means for beginning an on-line purchase by the customer and communicating to a server computer by the customer (col. 4, lines 20-24), means for determining that the customer is an acceptable credit risk for the on-line purchase using the customer's financial information which is based on the off-line transaction (col. 4, lines 24-29), and means for communicating to the customer that the on-line purchase has been approved, after said

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determining step determines that the customer is an acceptable credit risk (col. 4, lines 34-42) (Claims 1 and 24);

Means for issuing a bill for the on-line purchase (col. 5, lines 1-5) (Claims 9 and 32);

Means for issuing an electronic bill for the on-line purchase (col. 11, lines 4-13) (Claims 10 and 33);

Means for transmitting the electronic bill for the on-line purchase by email (col. 11, lines 4-13) (Claims 11 and 34);

Means for notifying said customer by an electronic mail message that said electronic bill is stored at the Internet site (col. 11, lines 4-13 and col. 5, line 60 through col. 6, line 4) (Claims 12, 13, 35 and 36);

Means for issuing a single electronic bill for both the on-line purchase and a lease corresponding to the off-line transaction (col. 11, lines 4-13) (Claims 14 and 37);

Means for printing a paper bill for the on-line purchase, and sending the paper bill to the customer (col. 11, lines 4-13) (Claims 15 and 38);

Means for debiting a pre-registered bank account by an amount corresponding to the on-line transaction (col. 11, lines 4-13) (Claims 16 and 39);

Means for debiting a pre-registered bank account by an amount corresponding to the on-line transaction and a payment for the off-line transaction (col. 11, lines 4-13) (Claims 17 and 40);

Means for charging a third party credit card of the customer for the on-line transaction (col. 2, lines 3-14) (Claims 18 and 41);

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Means for issuing a paper bill for said transaction if said financial information is not valid (col. 11, lines 4-14) (Claims 19 and 42);

Means for issuing the bill for the on-line purchase according to a predetermined billing cycle which is greater than one day (col. 2, lines 47-50) (Claims 20 and 43);

Means for issuing a single bill for plural transactions occurring over a time period (col. 5, lines 6-17) (Claims 21 and 44); and

Means for purchasing a product through the on-line purchase, the product being different from a product obtained through the off-line transaction (col. 5, lines 6-17) (Claims 22 and 45); and

Means for purchasing the product through the on-line purchase which is for use with the product obtained through the off-line transaction (col. 5, lines 6-17) (Claims 23 and 46).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-8 and 25-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Mandler et al. patent.

The Mandler patent discloses a method, and associated means, of communicating, comprising means for storing the customer's financial information based on a lease of an image

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forming device including that of a copier and a facsimile machine and up-to-date payments on the lease (col. 3, lines 39-43 and col. 4, lines 29-42) (Claims 2, 3, 4, 5, 6, 7, 25, 26, 27, 28, 29 and 30). Mandler discloses storing financial information based on a persons credit history, which inherently includes various types of goods and leases. Although Mandler doesn't specifically disclose a lease for an image forming device such as a copier and a facsimile machine, the Examiner takes official notice that such goods would fall within the purview of the type of goods covered in standard credit reports which are used as a basis for the credit analysis in Mandler.

The Mandler patent discloses a method, and associated means, of communicating, comprising means for communicating that the on-line purchase which is a purchase of supplies for an image forming device which has been obtained through the off-line transaction has been approved (col. 4, lines 29-42) (Claims 8 and 31). Mandler discloses communicating the transaction approval, just not that it was for the purchase of supplies for an image forming device. The types of goods purchased are merely descriptive, and since Mandler pertains to any type of goods purchases, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the purchase of supplies for an image forming device within the type of goods purchased in the Mandler invention. The Examiner takes Official Notice that the specific types of goods in the present application are a foreseeable good as anticipated by Mandler.

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Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Klingman, Silverman et al., Muftic, Shavit et al. and Conklin et al. patents are all directed to various types of online commerce. The Basch et al. and Walker et al. patents are for financial risk and credit review systems. The Elgamal patent is for an electronic accounts system. The Landry, Kight et al. and Kolling et al. patents are for electronic billing systems.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SS


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